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Legal Department, DL429
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ATTORNEY DOCKET NO. 10030988-1

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Miao Zhu

Serial No.: 10/797,651

Examiner: Brian J. Sines

Filing Date: March 10, 2004

Group Art Unit: 1743

Title: METHOD AND APPARATUS FOR SEQUENCING POLYMERS THROUGH TUNNELING
CONDUCTANCE VARIATION DETECTION

COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria VA 22313-1450

TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Sir:

Transmitted herewith is/are the following in the above-identified application:

- ☒ Response/Amendment ☐ Petition to extend time to respond
☐ New fee as calculated below ☐ Supplemental Declaration
☐ No additional fee (Address envelope to "Mail Stop Amendments")
☒ Other: 2 return postcards (Fee \$____)

CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY						
(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT	(3) NUMBER EXTRA	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEES
TOTAL CLAIMS		MINUS		= 0	X 50	\$ 0
INDEP. CLAIMS		MINUS		= 0	X 200	\$ 0
<input type="checkbox"/> FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM					+ 360	\$ 0
EXTENSION FEE	1 ST MONTH 120.00 <input type="checkbox"/>	2 ND MONTH 450.00 <input type="checkbox"/>	3 RD MONTH 1020.00 <input type="checkbox"/>	4 TH MONTH 1590.00 <input type="checkbox"/>		\$ 0
OTHER FEES						\$ 0
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$ 0

Charge \$0 to Deposit Account 50-1078. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 50-1078 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 50-1078 under 37 CFR 1.16, 1.17, 1.19, 1.20 and 1.21. A duplicate copy of this transmittal letter is enclosed.

Respectfully submitted,

Miao Zhu

By

Jacob N. Erlich
Attorney/Agent for Applicant(s)

I hereby certify that this correspondence is being Deposited with the United States Postal Service as First class mail in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450.

Date of Deposit: December 2, 2005

Typed Name: Jacob N. Erlich

Signature:

Reg. No. 24,338

Date: December 2, 2005

Telephone No. 617-854-4000

Application Serial No. 10/797,651
Response to Office Action dtd. 11/2/05
Response to Restriction Requirement dtd. 12/2/05



CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on December 2, 2005.

Jacob N. Erlich
Reg. No. 24,338

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Miao Zhu	Examiner: Brian J. Sines
Application Serial No.: 10/797,651	Group Art Unit: 1743
Filed: March 10, 2004	Confirmation No. 4197
Title: METHOD AND APPARATUS FOR SEQUENCING POLYMERS THROUGH TUNNELING CONDUCTANCE VARIATION DETECTION	

AGILENT TECHNOLOGIES, INC.
Legal Department, DL429
Intellectual Property Administration
P.O. Box 7599
Loveland, CO 80537-0599

To: Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION AND PROVISIONAL ELECTION **UNDER 37 CFR 1.143**

Sir:

The following is a request for reconsideration and withdrawal pursuant to 37 C.F.R. 1.143 of the requirement for restriction made under 35 U.S.C. 121 in an Office Action dated November 2, 2005, together with a provisional election of the claims of Group I.

The present application contains claims 1-34. In the Office Action, the Examiner restricts the claims as follows:

Group I. Claims 1-18 and 22-34, drawn to a method and apparatus for sequencing molecules of a polymer, classified in class 702, subclass 27.

Group II. Claims 19-21, drawn to a method for identifying a characteristic electrical signal of a chemically known molecule, classified in class 436, subclass 149.

The above restriction is respectfully traversed for the reasons set forth below. However, as required under 37 CFR 1.143, to complete the response, Applicants have provisionally elected Claims 1-18 and 22-34 of Group I.

The Examiner has considered the inventions to be distinct, each from the other, because the inventions of Groups I and II have different functions. The Examiner states that the invention of Group I is directed to a method and apparatus for sequencing molecules of a polymer whereas the invention of Group II is directed to a method for identifying a characteristic electrical signal of a chemically known molecule. The Examiner concludes by stating that, "Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classifications, restriction for examination purposes as indicated is proper."

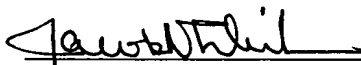
Applicant respectfully maintains that claims 1-34 are directed to the same invention and should be examined together since the inventions of Group I and Group II are so closely related together as to justify an examination of all of the claims as a single invention. Furthermore, it is well established that restriction is not mandatory merely because the subject matter of the claims may be directed to divergent subject matter. The fact that two methods, or a method and an apparatus may be searched in different subclasses, is not seen to be a material factor, at least insofar as the restriction requirement for the claimed invention is concerned. In fact, according to MPEP 803, "If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent and distinct inventions." In light thereof, it is believed that an action on the merits of claims 1-34 in a single application is in order.

In view of the foregoing discussion, Applicant submits that the requirement for restriction is improper and should be withdrawn. However, as stated above, Applicant has provisionally elected Group I, Claims 1-18 and 22-34, drawn to a method and apparatus for sequencing molecules of a polymer

Although it is believed that no fee is required to be submitted with this timely request, if indeed fees are required, please charge any underpayment of fees to or credit any overpayment of fees to Deposit Account No. 50-1078.

Respectfully submitted,
Miao Zhu, Applicant

Dated: December 2, 2005

By: 
Jacob N. Erlich
Reg. No. 24,338
Attorney for Applicant